



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

COPY MAILED

Paper No. 8

JUN 03 2002

**OPPENHEIMER WOLF & DONNELLY LLP
840 NEWPORT CENTER DRIVE, SUITE 700
NEWPORT BEACH CA 92660**

OFFICE OF PETITIONS

COPY MAILED

CANCELLED

OFFICE OF PETITIONS

In re Application of :
Robert A. Holzl et al :
Application No. 10/035,683 :
Filed: November 1, 2001 :
Attorney Docket No. 20451.12 :

ON PETITION

This is a decision on the petition under 37 CFR 1.78(a)(6), filed May 10, 2002, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of priority to an additional provisional application, namely, Application No. 60/245,248, filed November 2, 2000.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(5). In addition, the petition under 37 CFR 1.78(a)(6) must be accompanied by:

(1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5) of the prior-filed application, unless previously submitted;¹

¹ Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS)) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application was filed on November 1, 2001, within twelve months of the filing date of prior-filed provisional application, Application No. 60/245,248, which was filed on November 2, 2000, and for which a claim for priority is now being claimed. A reference to the prior-filed provisional application has been included in an amendment to the first sentence of the specification following the title.

The reference to the above-noted, prior-filed provisional application was not included in the manner specified in 37 CFR 1.78(a)(5) (i.e., in an ADS or in an amendment to the first sentence following the title of the specification) or filed within the period specified in 37 CFR 1.78(a)(5).

A reference to add the above-noted, prior-filed provisional application on page one following the first sentence of the specification has been included in an amendment filed on May 2, 2002. However, the amendment is not acceptable as drafted since it improperly incorporates by reference prior-filed provisional Application No. 60/245,248. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35 U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:

Section 120 merely provides a mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, supra at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and

express prohibition against new matter contained in section 251.

While it is recognized that the above-noted case speaks of priority benefits under 35 U.S.C. § 120, the same standard applies to those applications seeking priority benefits under 35 U.S.C. 119(e) after the filing of the nonprovisional application. Accordingly, before the petition under 37 CFR 1.78(a)(6) can be granted, a substitute amendment deleting the incorporation-by-reference statement is required.

Further, although the specification, as filed, includes a reference to another prior-filed provisional application, namely, Application No. 60/246,637 filed November 2, 2000 [sic, November 7, 2000] along with an incorporation-by-reference statement, it is improper to include such an incorporation by reference statement for an application not referenced on filing.

In order to expedite consideration, petitioner may wish to submit the substitute amendment by facsimile transmission to the number indicated below and to the attention of the undersigned. Any request for reconsideration of this decision should be filed within two months from the mailing date of this decision. Note 37 CFR 1.181(f).

Further correspondence with respect to this matter should be addressed as follows:

By mail: U.S. Patent and Trademark Office
P.O. Box 2327
Mailstop DAC
Arlington, VA 22202

OR

Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Any questions concerning this matter may be directed to the undersigned at
(703) 305-8680.

A handwritten signature in cursive script, reading "Frances Hicks".

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy